IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEAL AND INTERFERENCES

In re Application of	)	
	)	Group Art Unit 3625
Ronald Lourie	)	
	)	
Serial 09/884,868	)	Examinar: James F. Zurita
Filed: June 19, 2001	)	
For: Internet Cash Card	)	

APPEAL BRIEF

This is an appeal from the final rejection of the Examiner dated February 27, 2006, rejecting claims 1-5, all of the claims pending in the case. The requisite fee set forth in Rule 1.17, was previously paid.

Real Party in Interest

Ronald Lourie is the owner of patent application number 09/884,868, and the sole party of real interest.

Related Appeals and Interferences

There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

The application was filed June 19, 2001. Claims 1-5 in this application are pending and finally rejected. Appellant is appealing the rejections of all pending claims.

Status of Amendments

There are no pending amendments.

Summary of Claimed Subject Matter

The present invention relates to a method of performing an anonymous transaction. In particular, claim 1 provides a card of predetermined value with an indicia of identification associated with the card and an electronic means of transmitting information. The card is issued anonymously to a consumer in exchange for a predetermined denominational value that is associated with the card. The card is then presented to a merchant in a transaction for goods or services in an amount equal to or less than the value of the card. The card is verified through transmission of the indicia of identification and the amount of payment. An approval code is issued, wherein upon the transaction is completed. Funds are transferred to the merchant in the amount of the transaction.

Additional features of the claimed invention include transaction over a web site, the use of a card issuing authority and an acquiring bank, transferring payment from the acquiring bank to the merchant, and deducting the amount of the transaction from the predetermined value of the card.

In this manner, the claimed invention allows for an entirely secure and anonymous transaction between a merchant and a consumer. The invention substantially eliminates the risk associated with prior art credit card based transactions including, fraud, identity theft, and nuisance calls or communications associated with the disclosure of personal information between merchants gained in such transactions. Also, the method limits the risk of theft by allowing the consumer to limit the value of the card.

Grounds of Rejection to be reviewed on Appeal

Claims 1-5 have been rejected as unpatentable under 35 U.S.C. § 102(e) in view of United States Patent Nos. 6,473,500 (Risafi et al.).

Grouping of Claims

As to the rejections applied against claims 1-5 the rejected claims stand or fall together.

Argument

Rejection of Claims 1-5 based on 35 U.S.C. §102(e)

Applicant respectfully traverses the rejection of the claims under §102 on the grounds that the cited reference does not disclose all of the features of the claimed invention, namely, an anonymous method of transaction.

Risafi et al. disclose a prepaid card that a user can use to purchase goods and services. (See Abstract). Risafi et al. seek to combine the advantages of pre-paid cards associated with particular merchants – sometimes called gift cards, with traditional credit cards and so called TELCO cards. (See Background). Risafi et al. describe each of these systems and then offer a blended product that captures some aspects of each system. The cited patent, however, does not disclose the claimed invention. Instead, it presents in the abstract elements of the claimed invention in the context of a discussion of the prior art, and a disclosure of the claimed invention, but fails to disclose a product that fully embodies the concept of an anonymous method of transaction claimed by the present invention.

Claim 1 of the present application includes the limitation "issuing said card to a consumer anonymously in exchange for payment by said consumer of said predetermined denominational values associated with said card". In the pending office action, the Examiner defines the term "anonymous" as it applies to the above limitation in claim 1. The Examiner states that prior art will be interpreted to disclose an anonymous transaction/issuance when it discloses anyone of the following:

- purchasing a card with cash;

- providing a pre-paid card without verification of a purchasers identity; or
- purchasing a pre-paid card from a card-dispensing device.

(Page 4). This definition is erroneous because it is based on a misinterpretation of the use of the term "anonymous" in the present application, and the definition is overly dependent on the means of transaction and not the information conveyed during the transaction.

First, the Examiner relies on the text of the present application appearing on pages 9-10 to define the limitation "anonymous", this text states that "[t]he transaction would involve only the exchange of the card and the payment, with **no communication of personal information**". Thus, only the first prong of the Examiner's definition clearly meets the definition of anonymous set forth in the present application.

As to the second condition of anonymity set forth by the Examiner, personal information is not the same thing as verification of identify. The latter is a subset of the former. Identity is personal, but it is not the only kind of personal information. Plainly, a purchase that requires the use of information that is personal to the purchaser, such as a PIN, may not rise to the level of verification of personal identification (thereby meeting the Examiner's definition of anonymity), but would not be anonymous in the sense used in the claimed invention because it would include the use of information personal to an individual.

With regard to the third branch of the definition, purchasing a card from a dispensing machine by itself does not reveal anything about whether the purchase is anonymous. For example, an ATM machine generally cannot be used anonymously. The key is not if a device is used, but rather whether there is an exchange of personal information.

Returning to the cited reference, Risafi et al. do not disclose, teach, or suggest the anonymity limitation as set forth in the present application, but instead consistently teaches issuing the card along with a PIN (personal identification number). (See Abstract; Col. 3, lines 58-68; Col. 4, lines

17-22; Col. 6, lines 40-45). Nowhere do Risafi et al. indicate that the card can be used without a PIN.

Of course, a PIN is not anonymous. A PIN is a personal identifier. While a PIN may not readily identify an individuals identify, it is personally selected by a particular individual and is therefore personal information that is linked to the individual. Using the key passage in the present application cited by the Examiner, a PIN does not meet the requirement of anonymity. The text states that "[t]he transaction would involve only the exchange of the card and the payment, with **no communication of personal information**". Clearly, the use of a PIN does not meet this limitation, and is therefore not anonymous.

Having identified the problems with the Examiner's definition of anonymity, and applying the correct definition to the general nature of the disclosure of Risafi et al. to show that the reference does not disclose the claimed anonymous limitation, there is one other major problem with the Examiner's use of Risafi et al. Specifically, the Examiner cites to two passages in Risafi et al. in support of the fact that the reference teaches the anonymity limitation. One passage is a discussion of a prior art product that does not meet the other limitations of claim 1, and the other passage is a discussion of an invention that includes use of a PIN. Thus, neither passage discloses the claimed invention, nor can the two passages be combined because Risafi et al. contrast these citations against each other rather than teaching a combination.

The first passage appears at Col. 1, line 54 to Col. 2, line 8., and is a discussion of prior art pre-paid cards. The cards can be issued without the exchange of personal information, but otherwise fail to meet the limitations of claim 1. Pre-paid gift cards do not utilize the required verification step, issuance of an approval code step, or the transfer of funds from a card issuing authority step. Risafi et al. then go on to point out the drawbacks of this approach by specifically

pointing to the problem of anonymous nature of gift cards, and then expressly disavows anonymity by instead opting for a PIN. First, Risafi et al. points out the problem associated with gift cards.

> This type of prepaid card has several drawbacks. . . Finally, the card may arrive at the store already activated or may be activated in bulk, by the merchant upon receipt, subjecting them to possible unauthorized use. For example, the merchant's employees could use or give away the cards when the cards are at the store, or others could illegally use the cards if they are lost or stolen while being shipped to the merchant.

(Col. 2, lines 26-39). Next, Risafi et al. adopt the solution of non-anonymity to resolve the problem.

> Thus, the [Risafi et al.] card is more secure than a cash card because a PIN or verified signature may be required in order to use it. If the card user loses the card, not only can the card not be used by anyone else, but the card user may be able to recover the value of the card.

(Col. 7, lines 51-55). Risafi et al. reject anonymity in favor of the use of personal information for security. The discussion of the prior art pre-paid cards is presented not for the purpose of contemplation of an invention that meets the anonymity limitation of claim 1, but to specifically disclaim and disavow such an approach.

The second passage from Risafi et al. referenced by the Examiner also fails to disclose an anonymous method of issuing a card. (See Col. 6, lines 38-58). This passage states that a terminal such as an ATM, or any designated/approved card-dispensing device, can issue the cards. In this regard, the Examiner created a definition of an anonymous transaction - that states that anonymous issuance of a card will include a situation where an individual purchases a prepaid card at a card dispensing device, to conclude that this passage from Risafi et al. disclose the anonymous limitation.

This definition is too limiting because it assumes that a terminal or card-dispensing device cannot acquire personal information, Risafi et al. show that this is not the case. In the same passage cited by the Examiner, Risafi et al. state:

> The consumer then selects a PIN for the purchased card. The terminal then transmits the card identification data, PIN, and initial balance amount to the central processing center by any approved transmission medium or method . . .

(Col. 6, lines 52-55). Clearly, the mere fact that the card is issued by an electronic device does not mean the transaction is anonymous. The terminal is used to acquire and transmit personal information, namely, the consumers PIN.

Risafi et al. do not disclose the claimed invention, because it fails to disclose, teach, or suggest the issuance of a pre-paid card with the properties of a credit card in an anonymous manner. The mere fact that Risafi et al. includes a discussion of prior art pre-paid gift cards, which can be issued anonymously, and then later discloses the use of a pre-paid card that has the transactional properties of a credit card, does not disclose an anonymously issued pre-paid credit card. To make this leap the Examiner has taken the two disclosures in isolation, abstracted them out of context, and then combined them to allege the disclosure of an invention, which the reference actually teaches against. The Examiner skips over the parts of Risafi et al. that expressly disavow the combination suggested by the Examiner. 35 U.S.C. § 102 is not satisfied by assembling the pieces of a claimed invention from a document like a ransom note is assembled from a newspaper, but requires some disclosure of the invention as a whole. In this case, Risafi et al. fall well short of the target when it comes to satisfying the requirements of § 102 because it specifically warns against assembling the elements in the manner suggested by the Examiner, and as required by the claimed invention.

Accordingly, based on the foregoing Applicant respectfully submits that the prior art cited by the Examiner does not disclosed the claimed invention and the Board should reverse the Examiner's refusal to register claims 1-5 under 35 U.S.C. § 102.

Respectfully submitted,

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ATTORNEYS FOR APPLICANT

Claims Appendix

1. An anonymous method of transaction, said method comprising:

providing a card of predetermined denominational value having an indicia of identification associated with said card and said value;

providing an electronic means for transmitting information;

issuing said card to a consumer anonymously in exchange for payment by said consumer of said predetermined denominational value associated with said card;

presenting said card to a merchant as transactional payment to said merchant for a transaction of goods or services, wherein said transactional payment by said consumer to said merchant is less than or equal to said predetermined denominational value associated with said card;

verifying said card by transmitting with said electronic means said indicia of identification and the amount of said transactional payment by said consumer to said merchant, to a card issuing authority;

issuing with said electronic means an approval code from said card issuing authority to said merchant;

completing said transaction with said merchant by providing said goods or services to said consumer; and

transferring funds from said card issuing authority to said merchant in the amount of said transactional payment from said consumer to said merchant.

2. The invention in accordance with claim 1 wherein said merchant has a Web site and said transaction takes place through said merchant's web site.

3. The invention in accordance with claim 1 wherein said step of verifying said card by transmitting with said electronic means said indicia of identification to a card issuing authority and said step of issuing with said electronic means an approval code from said card issuing authority to said merchant, further comprises first transmitting said indicia of identification and the amount of said transactional payment from said consumer to said merchant, said merchant's acquiring bank and then to said card issuing authority, and then issuing an approval code from said card issuing authority to said merchant's acquiring bank and then to said merchant.

4. The invention in accordance with claim 3 wherein said step of transferring funds from said card issuing authority to said merchant in the amount of said transactional payment from said consumer to said merchant, further comprises first transferring said transactional payment from said consumer to said merchant's acquiring bank and then to said merchant.

5. The invention in accordance with claim 1 further comprising the step of deducting the amount of said payment from said consumer to said merchant, from said predetermined denominational value of said card upon issuing said approval code.

Evidence Appendix

There is no evidence submitted herewith.

Related Proceedings Appendix

There are no related proceedings.